

In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other. (Emphasis Added)

A review of the newly cited Yamashita reference reveals that, while the issue date is March 19, 2002 thereby making the reference available as prior art under only sections (e), (f), or (g) of §102, the filing date is March 31, 1999. Since the filing date of the instant application is March 16, 1999, the Yamashita reference is not prior art under any section of §102 since 1) the reference is not **“before the invention by the applicant for patent”** and 2) the invention presently claimed is not the same as that claimed by Yamashita (compare claim 1 of Yamashita with the instant claims 1 and 20).

Consequently, since the Examiner admits at pages 3 and 9 of the May 13, 2002 Office Action, that:

“Goldschmitt and The Mail do not explicitly disclose associating the preselected advertisement with said communication within the user-managed data processing system” and

“Goldschmitt does not explicitly disclose transmitting the electronic communication including the advertisement using the user managed data processing system associated with the sending party”

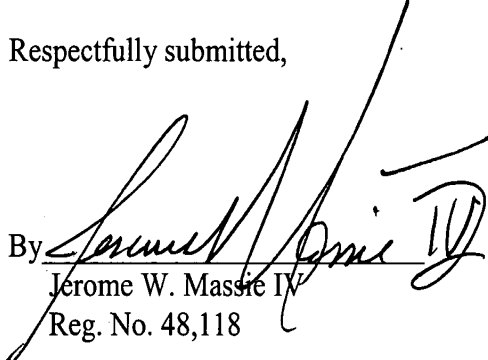
and since Yamashita was the only reference of record which allegedly disclosed these features, a *prima facie* case of obviousness has not been set forth for any of the above rejections under §103, and therefore, all the §103 rejections of record have been made in error and must be withdrawn.

### CONCLUSION

Having responded to all rejections set forth in the outstanding Office Action, it is submitted that claims 1-22 are now in condition for allowance. An early and favorable

Notice of Allowance is respectfully solicited. In the event that the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, the Examiner is courteously requested to contact Applicants' undersigned representative.

Respectfully submitted,

By   
Jerome W. Massie IV  
Reg. No. 48,118

Nixon Peabody LLP  
8180 Greensboro Drive, Suite 800  
McLean, Virginia 22102  
(703) 770-9300  
(703) 770-9400 (fax)

CML/JWM